

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:) Confirmation No.: 2970
Shunpei YAMAZAKI) Group Art Unit: 2822
Serial No. 10/045,902) Examiner: Roy Karl Potter
Filed: January 16, 2002)
For: SEMICONDUCTOR HAVING LOW)
CONCENTRATION OF)
PHOSPHOROUS)

APPELLANT'S REQUEST FOR REHEARING UNDER 37 CFR § 41.52

Mail Stop Appeal Brief - Patents
Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Decision on Appeal (the "Decision") of the Board of Patent Appeals and Interferences (the "Board") mailed January 11, 2011, has been received and its contents carefully noted. This Request for Rehearing is filed within two months of the original Board decision and therefore is believed to be timely under 37 CFR § 41.52(a)(1). In addition, other than addressing new arguments with respect to the interpretation of 35 U.S.C. § 251 asserted for the first time in the above-referenced Decision, this Request for Rehearing includes no new arguments or evidence and maintains the arguments of the Appeal Brief. Accordingly, the Appellant respectfully submits that this Request for Rehearing is proper under 37 CFR § 41.52(a) and requests rehearing for the reasons detailed below.

The Decision holds that "the '991 patent expired with the '476 patent on December 22, 2003" and that "[b]ecause there is no remaining unexpired term of the original '991 patent, the Office is not permitted by § 251 to reissue the '991 patent, and thus Appellant

has failed to state an error correctable under 35 U.S.C. § 251.” The Appellant notes that the Decision appears to be based entirely on the Office’s allegedly immutable lack of authority under § 251. Furthermore, the Decision appears to predicate such authority entirely on the meaning of “the term of the original patent” recited therein¹. Accordingly, the Appellant understands that the Decision appears to stand or fall based on the meaning of “the term of the original patent.” In reaching its contrary conclusion that the ‘991 patent is now expired, the Board overruled its previous holding, in Ex Parte Durckheimer, Appeal No. 94-2004, that:

A terminal disclaimer does not alter “the term of the original patent.” Rather, a terminal disclaimer is only a “disclaim[er] [of a] terminal part of the term, of the patent granted or to be granted.”

Specifically, the Board now holds that “[w]e interpret ‘the term of the original patent’ in § 251 to refer to the ‘term’ of the patent as the term set upon issuance of the original patent,” that “the Federal Circuit has recognized that under § 253 the expiration date of the patent subject to the terminal disclaimer is ‘reset’ to the expiration date of the patent referenced in the terminal disclaimer” and that “[t]hus, we disagree with the Board’s earlier holding in Durckheimer that a terminal disclaimer does not alter ‘the term of the original patent’” (Dec. 11). Further in support of its holding, the Decision finds that “§ 154 was subsequently amended to specifically recognize that patent term can expire based upon a terminal disclaimer,” stating “35 U.S.C. § 154(b)(2)(B) ... amended by PL 106-113 § 4402(a) in 1999 ... recites that patent term adjustments for patents having a disclaimed portion are prohibited from adjustment “beyond the expiration date specified in the disclaimer” (Id.). However, as described in detail below, this position is contrary to the explicit meaning of “term” mandated by statutory law, and contradicts the various holdings relied on by the Board in reaching its decision. The Appellant respectfully submits that §

¹ Specifically, the Decision concludes that “35 U.S.C. § 251 does not authorize the Office to reissue a patent that has expired based on an expiration date set at the time of issuance of the original patent” and that “35 U.S.C. § 251 does not authorize the Office in reissue to expand the term of a patent beyond the term of the original patent set at the time of issuance” (Dec. 13).

251 permits the Office to reissue the '991 patent for the unexpired part of the term of the original patent and that this statutory grant persists until January 30, 2018.

Remarkably, while the Board goes to great lengths to justify its definition of "term," the Board never refers to or cites the very statutory provision enacted by Congress to expressly define the term of a patent grant. Specifically, 35 U.S.C. § 154(a)(2) ("TERM") establishes that (emphasis added):

...such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed.

The Board's shoehorning of § 154(b)(2)(B) into its already contorted definition of "the term of the original patent" is especially troubling, in that 35 U.S.C. § 154(b) only purports to describe "ADJUSTMENT OF PATENT TERM" (title) and does not establish or otherwise define what constitutes "the term of the original patent" issuing pursuant thereto. Moreover, § 154(b)(2)(B) merely precludes further *adjustment* to the term beyond a disclaimed date and does not operate to shorten (or for that matter enlarge) the base term. Accordingly, it is respectfully submitted that the Decision improperly relies on §154(b)(2)(B) to define or limit the meaning of "the term of the original patent," which is clearly defined in section § 154(a).

Furthermore, although such "term" may otherwise be adjusted, extended or subjected to disclaimer, the meaning of term pursuant to § 251 should not be maintained in flux. For example, 35 U.S.C. § 253 states that "any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted" (emphasis added). Under the Board's definition of "the term of the original patent," a terminal disclaimer would operate to "reset" the patent term and does not merely *disclaim or dedicate* the part of the term at issue. However, if "the term of the original patent" were defined in part by the filing of a terminal disclaimer, then such term would remain in flux throughout the lifetime of the patent, potentially subjected to the

subsequent filing of a disclaimer. As such, the “term of the original patent” could never truly be established or settled until the patent itself had expired. The Appellant respectfully submits that Congress never intended the *statutory grant* of patent term to be vague and indeterminate awaiting the transitory goals of the patentee to resolve.

This concept of an absolute patent term, that may otherwise be adjusted, extended or subjected to disclaimer, is further evidenced by 35 U.S.C. § 154(c)(1). As the Federal Circuit noted in Bayer AG v. Carlsbad Tech., Inc., 298 F.3d 1377 (Fed. Cir. 2002) (emphasis added):

In response to public comments on its rules to implement the new twenty-year term, the PTO stated: A patent that is in force on June 8, 1995, or a patent that issues after June 8, 1995, on an application filed before June 8, 1995, is automatically entitled to the longer of the 20-year patent term measured from the earliest U.S. effective filing date or 17 years from grant. This is automatic by operation of law.

The Appellant respectfully submits that “the term of the original patent” is not set or shortened based upon the filing of a terminal disclaimer. To the contrary, “term” is set by statutory grant and is automatic by operation of law, but may nonetheless be *disclaimed* by the filing of a terminal disclaimer. While a terminal disclaimer may *disclaim* some unexpired portion of the patent term that is explicitly defined by statute, it does not cause the “patent term” itself to *expire*, as the Decision suggests. This is self-evident from the very concept of a “terminal disclaimer.” Therefore, the Appellant respectfully submits that Congress quantified absolute limits for what was meant by term and expiration, and the provisions of 35 U.S.C. § 154 set forth with certainty such term at the time of issuance.

The Board relied on Bayer AG for the holding that “the expiration date of the [terminally disclaimed patent], which is contingent upon the expiration date of the [parent patent], also changed simultaneously to December 9, 2003” (Dec. 7). The Appellant respectfully disagrees and traverses the Board’s application of the holding in Bayer. Bayer supports a conclusion that an expiration date of a patent is not immutably controlled by the provisions of a terminal disclaimer, even when an absolute date is

referenced therein. Bayer AG at 1381 and 1382. The result in Bayer directly contradicts the current position of the Board and does not support a conclusion that term is “reset” at issuance by the filing of a terminal disclaimer. To the contrary, the Federal Circuit in Bayer evaluated term such that the *explicit* provisions of the terminal disclaimer at issue were negated. Id. As a result, the court determined that the provisions of the terminal disclaimer *itself* may be modified by operation of law, such that the statutory grant of patent term is not invariably constrained by the filing of a terminal disclaimer. Id. That is, it is the statutory grant that is controlling. It is this statutory grant, not the express provisions of a terminal disclaimer, which define the term of a patent.

Further still, in concluding that a terminal disclaimer may somehow be incorporated to define term or the expiration thereof, the Board relies on Merck & Co. v. Hi-Tech Pharmacal Co., 482 F.3d 1317, 1319, 1322-23 (Fed. Cir. 2007) for the finding that “computation of a Hatch-Waxman patent term extension [under 35 U.S.C. § 156] is from the expiration date resulting from the terminal disclaimer and not from the date the patent would have expired in the absence of the terminal disclaimer” (Dec. 6). The Appellant respectfully disagrees with the Board’s description of the holding in Merck. To the contrary, Merck held that “§ 156 does not expressly reference terminal disclaimers,” while “§ 154(b)(2)(B) expressly excludes patents in which a terminal disclaimer was filed from the benefit of a term adjustment for PTO delays.” Merck at 1321 and 1322. Therefore, the Federal Circuit concluded that “a patent term extension under § 156 is not foreclosed by a terminal disclaimer.” Id. at 1322. In reaching its “flexible approach” to the application of patent term extension, the Federal Circuit, citing Merck & Co. v. Kessler, 80 F.3d 1543, 1547 (Fed.Cir.1996), noted that (emphasis added):

“In Merck, we held that § 156 ‘requires a more flexible interpretation of the phrase ‘original expiration date.’” 80 F.3d at 1551. We stated that ‘original expiration date’ in § 156 ‘means no more than that the expiration date has not been extended under [§ 156] and, thus, the phrase can identify more than one date.’” Id. at 1323.

Merck does not define the word “term” but, at most, relies on Merck & Co. v.

Kessler to suggest a flexible interpretation of the phrase "original expiration date" that reflects "more than one date," as necessary to reconcile the provisions of § 154(b)(2)(B) and § 156. Accordingly, Merck does not support the Board's conclusion that the "term of the original patent" is defined by the filing of a terminal disclaimer, much less when construed pursuant to § 156.

For the foregoing reasons, the Appellant respectfully submits that the meaning of "the term of the original patent" is not defined by the act of filing of a terminal disclaimer, but that a terminal disclaimer may instead operate to disclaim such term (or terminal part thereof). Accordingly, it is respectfully submitted that the Board has the authority to reissue the '991 patent during the remainder of its term. The expiration date of the present '991 patent is January 30, 2018. Therefore, there is an unexpired part of the term of the original '991 patent and reissue is proper and authorized by § 251.

Furthermore, as noted above, the Board relies extensively on the precept that the Office is unable to reissue the patent based on the finding that the patent expired on December 22, 2003 and that "§ 251 does not authorize the Office to reissue a patent that has expired based on an expiration date set at the time of issuance of the original patent" (Dec. 13). **However, the present reissue application was filed on January 16, 2002, well before even the alleged expiration of the '991 patent.** Therefore, in holding that "35 U.S.C. § 251 does not authorize the Office to reissue a patent that has expired based on an expiration date set at the time of issuance of the original patent," the Decision appears to suggest that its authority to act pursuant to § 251, *vel non*, may somehow be predicated on the Office's egregious delays during the nearly ten year examination of the subject reissue application. However, the Appellant respectfully traverses the suggestion that the Office can avoid or impair its own authority to act on a reissue application simply by delaying action on it or that while reissue under § 251 potentially existed as a remedy for nearly two years during the pendency of the present application, the Office's arbitrary failure to grant such remedy may somehow invalidate its authority to do so. To hold otherwise would render the provisions of § 251 ineffective in that the Office could avoid

every reissue application by simply refusing or egregiously delaying action thereon until the Office itself lacked the authority to act.

Specifically, as described in detail in the Appeal Brief and in the Reply Brief, after the present reissue application was filed, the Patent Office, over a period of more than nine years, variously refused to reissue the '991 patent, agreed to reissue, delayed reissue for more than two years before again refusing reissue, then caused more than two years of additional delays during the course of this Appeal. Now, for the first time during the nearly ten year pendency of the subject reissue application, the Patent Office proposes a creative definition of "term" that overrules its own prior definition and that, nonetheless, is directly contrary to the clear statutory mandate of a patent term that ends "20 years from the date on which the application for the patent was filed in the United States," apparently to justify its egregious delays in examining the subject reissue application. Such conduct is, by definition, arbitrary and capricious.

The Appellant appreciates that the Board is "mindful of the prosecution delays suffered by Appellant." However, notwithstanding the Board's sympathies, reissue of the '991 patent is the appropriate remedy for the Office's many failures in the subject application and is the only adequate response to the unjust impairment of the Appellant's patent grant. Reissue remains a proper remedy and may not be avoided by the Office's own untimeliness in the subject application. As noted in the Reply Brief, the Federal Circuit and its predecessor, the Court of Customs and Patent Appeals (CCPA), have generally held that the reissue statute "is remedial in nature, based upon fundamental principles of equity and fairness, and should be construed liberally."² In the present application, the Appellant respectfully submits that equity and fairness weigh profoundly for the Appellant, for reissue, and the reissue statute must be "construed liberally" in favor thereof.

² In re Weiler, 790 F.2d 1576, 1579, 229 USPQ 673, 675 (Fed. Cir. 1986); see also In re Doyle, 293 F.3d 1355, 1358, 63 USPQ2d 1161 (Fed. Cir. 2002); Hester Industries, Inc. v. Stein, Inc., 142 F.3d 1472, 1479-80, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998); and Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993).

As such, the Appellant respectfully submits that the error of the Examiner and the U.S. Patent Office in failing to consider and act upon a *Petition Under 37 CFR § 1.182 to Withdraw a Terminal Disclaimer* filed 21 months before issuance of a patent is an error under 35 U.S.C. § 251 that is correctable by reissue, and that the errors of the Appellant (1) in failing to ensure proper disposition of the *Petition Under 37 CFR § 1.182 to Withdraw a Terminal Disclaimer*, (2) in not withdrawing the application from issuance under 37 CFR § 1.313 before the payment of the issue fee, (3) in not withdrawing the application from issuance under 37 CFR § 1.313 after the payment of the issue fee, and (4) in not deferring issuance of the patent under 37 CFR § 1.314 until the outstanding *Petition* was considered are errors under 35 U.S.C. § 251 that are correctable by reissue, that the basis for the reissue is proper, that the reissue oath/declaration is proper and that there is remaining unexpired term of the original patent such that the Office has authority to act pursuant to § 251.

For the reasons set forth herein and in the foregoing Appeal Brief and Reply Brief, the *Petition Under 37 CFR § 1.182 To Withdraw a Terminal Disclaimer* should be granted, the *Terminal Disclaimer* should be withdrawn, and the face of the patent should be corrected by reissuing the '991 patent in order to delete the following on the face of the patent: "This patent is subject to a terminal disclaimer." If other suitable remedies are available to correct the errors in the present patent, the Appellant respectfully requests that such actions be taken.

Should the Board or the Examiner believe that anything further would be desirable to place this application in better condition for appeal, the Board or the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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